UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,277	07/18/2003	John McGregor	C330.101.101	2411

25281 7590 01/08/2008

DICKE, BILLIG & CZAJA
FIFTH STREET TOWERS
100 SOUTH FIFTH STREET, SUITE 2250
MINNEAPOLIS, MN 55402

EXAMINER	
FU, HAO	
ART UNIT	PAPER NUMBER
4172	
MAIL DATE	DELIVERY MODE
01/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/623,277	MCGREGOR ET AL.	
	Examiner	Art Unit	
	Hao Fu	4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejection 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1, 4, 12, and 13 are rejected under U.S.C. 102 (e) as being anticipated by Miyamoto et al. (Pub. No.: US 2003/0110121).

As per claim 1, Miyamoto teaches a method for funding an infrastructure or building initiative (see abstract and paragraph 0002; prior art teaches specifically a method for funding a power plant, which is referred to as an infrastructure according to paragraph 0055; in addition, paragraph 0002 clearly shows the anticipation that this method can be applied to transportation facility as well), the method comprising collecting payments from parties who stand to financially benefit from the initiative and using these payments to partly or wholly fund the initiative (see abstract, paragraph 0001, 0007, 0008, 0018, and 0032; prior art teaches collecting fund from electric consumers who receive financial benefit from the establishment of the power plant in the form of getting discount on their electrical bill payment, and this funding is used to partly fund the initiative).

As per claim 4, Miyamoto teaches involving assessing a measure of savings made by provision of the initiative (see paragraph 0032; prior art mentions about making a comparison between costs of the improvement of infrastructure of respective investors and advantages of being invested; this comparison is a measure of saving).

As per claim 12, the parties who stand to financially benefit include landowners and/or developers and/or companies (see paragraph 0025, especially "obtain a fund by selling such securities or equivalent credit granting units to an electricity consumer, including enterprises and individuals who own equipment that consume power in a neighboring area of the power plant to be constructed..."; also see paragraph 0052).

As per claim 13, Miyamoto teaches the initiative is a transport initiative (see paragraph 0002 last sentence, prior art clearly shows the intention that the invention can be applied to transport initiative).

Claim Rejection 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (Pub. No.: US 2003/0110121), in view of Bowes (Identifying the impacts of rail transit stations on residential property value in Atlanta, AAT 9954111).

As per claim 2, Miyamoto does not teach involving assessing a measure of an increase in property value that is created by provision of the initiative.

Bowes teaches assessing a measure of an increase in property value that is created by provision of the rail transit, which is a transportation infrastructure (see first paragraph under abstract)

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include assessing a measure of an increase in property value that is created by provision of the initiative.

One of ordinary skill in the art would have been motivated to modify the reference in order to calculate the amount of fund that will likely be collected to fund the infrastructure.

As per claim 5, Miyamoto teaches involving assessing a measure of savings made by provision of the initiative (see paragraph 0032; prior art mentions about making a comparison between costs of the improvement of infrastructure of respective investors and advantages of being invested; this comparison is a measure of saving).

Claim 3, 6, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (Pub. No.: US 2003/0110121), in view of Bowes (Identifying the impacts of rail transit stations on residential property value in Atlanta, AAT 9954111), and further in view of Official Notice.

As per claim 3, Miyamoto does not each payment collected is a percentage of the assessed increase in value.

Official Notice is taken that collect each payment as a percentage of the assessed increase in value, which is essentially same as property tax, is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include each payment collected is a percentage of the assessed increase in value.

One of ordinary skill in the art would have been motivated to modify the reference in order to specify the payment amount.

As per claim 6, Miyamoto teaches involving assessing a measure of savings made by provision of the initiative (see paragraph 0032; prior art mentions about making a comparison between costs of the improvement of infrastructure of respective investors and advantages of being invested; this comparison is a measure of saving).

As per claim 14, Miyamoto does not teach the percentage is a pre-determined percentage.

Official Notice is taken that setting the payment/investment amount as a pre-determined percentage (property tax is collected at a pre-determined percentage of the property value) is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include that the percentage is a pre-determined percentage.

One of ordinary skill in the art would have been motivated to modify the reference in order to specify the payment amount.

Claim 7, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (Pub. No.: US 2003/0110121), in view of Official Notice.

As per claim 7, Miyamoto teaches each payment amount collected is related to the assessed savings amount (see paragraph 0034; "according to the present invention allows a substantial discount of power charge according to the investment amount";

investment amount is the payment consumer pay to fund the infrastructure, and discount amount is saving amount; therefore, Miyamoto discloses that payment amount is related to saving amount). However, Miyamoto does not teach each payment collected is a percentage of the assessed saving.

Official Notice is taking that any two numbers can be percentage of each other is old and well known in the art. For example, 10 is 10% of 100, 100 is 1000% of 10. Payment amount and saving amount are two numbers, therefore, they are percentage of each other.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include each payment collected is a percentage of the assessed saving.

One of ordinary skill in the art would have been motivated to modify the reference in order to specify the payment amount.

As per claim 8, Miyamoto teaches involving assessing parties that may be interested in providing funds and entering negotiations with those parties (see paragraph 0069 through 0073; assessing/assessment is the process of documenting, usually in measurable terms, knowledge, skills, attitudes, and belief; prior art teaches giving investment options for the investors, signing contracts with the investors, and further record and maintain updates of the contract; it is considered as a process of documenting, and paragraph 0070 suggests negotiation process with the investors).

Examiner notes however, Miyamoto does not teach to keep the negotiations confidential.

Official Notice is taken that keeping negotiations confidential is old and well known in the business art.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to keep the negotiations confidential.

One of ordinary skill in the art would have been motivated to modify the reference in order to protect the privacy of the investors.

As per claim 15, Miyamoto does not teach the percentage is a pre-determined percentage.

Official Notice is taken that setting a percentage as a pre-determined percentage is old and well known in the art. For example, the property tax is a percentage of property value, and this percentage is a pre-determined percentage.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to specify percentage is a pre-determined percentage.

One of ordinary skill in the art would have been motivated to modify the reference in order to specify the payment amount.

Claim 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (Pub. No.: US 2003/0110121), in view of Killick (Developers Build Rungs at the Bottom of the Ladder, Financial Times, Feb 12, 2003. pg. 04).

As per claim 9, Miyamoto does not teach involving applying for or granting planning permission to build or re-build property in a property up-lift area.

Killick teaches involving applying for or granting planning permission to build or re-build property in a property up-lift area (see title and second paragraph under full text; it is a common knowledge that planning permission is needed before property can be legally built, which is implied by Killick; also see paragraphs starts in the middle of page 2 to the bottom of page 2, it is suggested that the properties are built near the main rail termini, which is a property up-lift area according to applicant's definition).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include applying for or granting planning permission to build or re-build property in a property up-lift area.

One of ordinary skill in the art would have been motivated to modify the reference in order to legalize the construction.

As per claim 10, Miyamoto does not teach the property up-lift area is a pre-defined or designated area in a vicinity of the initiative.

Killick teaches the property up-lift area is a pre-defined or designated area in a vicinity of the initiative (see paragraph starts with "Jonathan Seal, managing director of..." on page 2; Killick discloses that properties are built near the main rail termini, which is a pre-defined area in a vicinity of the initiative).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to define the property up-lift area is a pre-defined or designated area in a vicinity of the initiative.

One of ordinary skill in the art would have been motivated to modify the reference in order to clarify the building site.

Claim 11 is rejected rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (Pub. No.: US 2003/0110121), in view of Dalya Alberge (Theatre to get back its Edwardian glory, The Times, Sep 8, 1994).

As per claim 11, Miyamoto does not teach the step of collecting payments is done after planning permission is granted to a property developer and the initiative is committed.

Dalya Alberge teaches the step of collecting payments is done after planning permission is granted to a property developer and the initiative is committed (see second last paragraph, "ENO will also raise funds...").

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include the step of collecting payments is done after planning permission is granted to a property developer and the initiative is committed.

One of ordinary skill in the art would have been motivated to modify the reference in order to protect investors.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hao Fu whose telephone number is (571) 270-3441. The examiner can normally be reached on Mon-Fri/Mon-Thurs 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 4172

Hao Fu
Examiner
Art Unit 4172

Nov-07